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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,462	01/23/2004	Kenji Yamamoto	4710-0106P	5476

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BIRCH STEWART KOLASCH & BIRCH
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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

NOTIFICATION DATE	DELIVERY MODE
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08/22/2007

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/762,462	Applicant(s) YAMAMOTO ET AL.	
	Examiner Margaret G. Moore	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2 to 4, 9 to 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 to 4, 9 to 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/6/07 has been entered.

2. Claims 2 to 4 and 9 to 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As amended, the location of the phrase "and/or a condensate" is confusing and unclear. The newly added language "by mixing the silane..." appears to refer to the silane having been converted to silanol by hydrolyzing the hydrolyzable group. This language should follow the step it further modifies rather than be just tacked onto the description of (G).

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 2 to 4 and 9 to 16 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over DE 24 49 085.

The teachings of DE 24 49 085 and how they apply to the instant claims have been addressed in previous office actions. In an effort to overcome the obviousness rejection applicants have amended the claim to require that the silane (G) be converted to silanol by mixing the silane with water prior to adding the silane to other components. For various reasons, this fails to overcome the instant claims.

Initially, the Examiner notes that she interprets the language in claim 2 as meaning that (G) can be a silanol prepared by mixing the silane with water prior to adding it to other components or it can be a *condensate of such a silanol*. This point is being made

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because, as noted supra, the location of the language "by mixing the silane (G) with water..." in this claim is somewhat confusing.

a. It is based on the fact that (G) can be a condensate of the silanol that the following anticipation rejection rationale applies. The Examiner had not previously given this component its broadest reasonable interpretation.

The phrase "condensate of the silanol" is, in fact, quite broad as many or even most siloxanes can be prepared by the general step of "condensing silanol groups". With this in mind, the polysiloxane having terminal hydroxyl groups meeting claimed component (A2) and found in the working examples meets this requirement as this is the condensate of a dimethyl-disilanol. Note that the hydroxyl terminated siloxane (A2) can be present in any amount and, given the very large weight range of (B), the amount of hydroxyl terminated siloxane in Example 3 meets both component (A2) and (G) in claim 2.

b. In addition to this anticipation, the Examiner makes the following rejection based on the obviousness of the claims.

The Examiner maintains the position that it would have been obvious to add the silane condensate shown on page 4 of the English language translation to a composition containing the Si-H crosslinking agent. This position was addressed in the office action dated 3/9/07, paragraph 4, page 3. On the top of page 11 of applicants' reply of 6/11/07, it is argued that

... there must be a reason to make this combination - a person of ordinary skill in the art must expect some advantageous result from the combination in order for the combination to be "obvious." The Examiner has not met the burden of providing this reason.

While the Examiner agrees that there must be a reason to make the combination, this is not the same as "expect some advantageous result from the combination". The examiner recognizes that obviousness can only be established by modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves

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or in the knowledge generally available to one of ordinary skill in the art. In this case, the Examiner has provided two different rationales for the obviousness of the combination of crosslinking agents. The final rejection clearly identified two different reasons that would have prompted a person of ordinary skill in the art to combine the elements in the way they are combined in the claimed invention. Thus the Examiner has, in fact, met her burden.

c. Using yet another rationale, note the following 102/103 rejection. The language "by mixing the silane (G) with water (E) prior to adding the silane (G) to other components" is a product by process type limitation. The epoxy silane taught on page 6 of the English language translation is not specifically taught as being hydrolyzed prior to addition but it will hydrolyze when it is mixed with water *after* adding the silane to other components. It would appear that the final product, i.e. a hydrolyzed silane, will inherently be the same regardless if it is hydrolyzed prior to or after addition to other components. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. Please note MPEP 2113, which addresses the appropriateness of a rejection under 35 USC 102/103 for product by process claims.

Applicants argue that mixing the silane with water prior to the other components improves oil repellency of a coating, but fail to provide any or sufficient evidence of this.

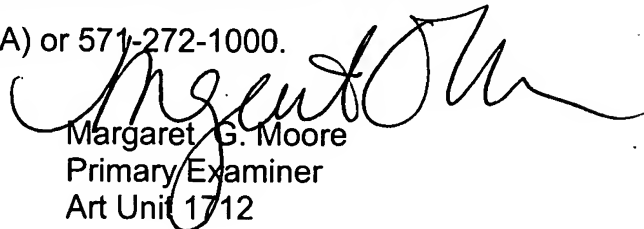
5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday and Wednesday to Friday, 10am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski can be reached on (571) 272-1302. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
8/16/07